



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/508,932

09/24/2004

Jeffrey P. Demuth

31169-705.831

9878

21971

7590

05/20/2009

WILSON SONSINI GOODRICH & ROSATI

650 PAGE MILL ROAD

PALO ALTO, CA 94304-1050

EXAMINER

MYERS, CARLA J

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

05/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

The amendment filed on April 9, 2009 amending all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because the claims are not directed to the elected invention of a method for determining whether an agent can be used to reduce proliferation or cause death of a cancer cell by determining the level of expression of EACH of the marker genes ABCC5, GTF2H2 AND ERCC2. Rather, in the response of April 9, 2009, Applicant amended the claims to recite “determining and quantifying the level of expression of a marker gene in said lung cancer cells, wherein said marker gene is ABCC5, GTF2H2 or ERCC2. However, the elected invention is not limited to the detection of one of marker genes of ABCC5, GTF2H2 or ERCC2. The elected invention requires the detection of all 3 of the marker genes. Note that a letter was sent to Applicants on April 30, 2008 indicating that Applicant’s prior response to the election requirement was not fully responsive because Applicant did not elect a particular marker gene or a particular combination of marker genes. On May 20, 2008, Applicant’s representative contacted the examiner to clarify the election by phone. Applicant’s election of the combination of all of the marker genes of ABCC5, GTF2H2 and ERCC2 is clearly set forth in the interview summary of May 22, 2008 and in the Office action of October 10, 2008. Thereby, the present claims drawn to methods of detecting the expression level of one of ABCC5, GTF2H2 or ERCC2 do not read on the elected invention which requires detecting the expression level of each of ABCC5, GRF2H2 and ERCC2.

Art Unit: 1634

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is 571-272-0747. The examiner can normally be reached on Monday-Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carla Myers/

Primary Examiner, Art Unit 1634